

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte BETTY A. HARRIS

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Appeal No. 99-0643  
Application No. 08/828,225<sup>1</sup>

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ON BRIEF

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Before STAAB, McQUADE, and BAHR, Administrative Patent Judges.  
BAHR, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 10 through 14 and 16, which are all of the claims pending in this application. Claim 10 was amended and claim 15 was canceled in Paper No. 15, filed March 4, 1998, after the final rejection

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<sup>1</sup> Application for patent filed March 13, 1997. According to the appellant, the application is a continuation of Application 08/515,387, filed August 15, 1995, now abandoned.

Appeal No. 99-0643  
Application No. 08/828,225

We REVERSE.

BACKGROUND

The appellant's invention relates to a key lock for a vehicle in combination with an ignition switch. An understanding of the invention can be derived from a reading of exemplary claim 10, which reads as follows:<sup>2</sup>

10. A key lock for a vehicle in combination with an ignition switch lock cylinder having a face and a keyhole therein, the keyhole of the ignition switch lock cylinder having a length greater than its width, the key lock comprising:

a pair of separate, rectangular planar flanges disposed in parallel planes on opposite sides of the keyhole, each having a throughbore, said flanges permanently secured to the face of said ignition switch lock cylinder and extending parallel to the length of the keyhole; and

a padlock having a shackle, said shackle received through the throughbores of said flanges, said shackle positioned to prevent unauthorized access to the keyhole of said ignition switch cylinder, said padlock being selected from the group consisting of a key-type lock, a combination-type lock and a cylinder-type lock.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

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<sup>2</sup> In contrast to the examiner's statement in section (8) on page 2 of the answer, we find that the copy of claim 10 in appellant's supplemental brief is substantially different from claim 10 as last amended on March 4, 1998. These differences include but extend substantially beyond appellant's failure to include the amendments made to claim 10 in the March 4, 1998 amendment (see Paper No. 15 and Paper No. 16).

|       |           |               |
|-------|-----------|---------------|
| Capri | 3,874,204 | Apr. 1, 1975  |
| Nagy  | 4,732,024 | Mar. 22, 1988 |

The following rejection is before us for review.

Claims 10 through 14 and 16 stand rejected under 35  
U.S.C.

§ 103 as being unpatentable over Nagy in view of Capri.

The complete text of the examiner's rejection and response to the argument presented by the appellant appears in the answer (Paper No. 22, mailed September 18, 1998), while the complete statement of the appellant's argument can be found in the supplemental brief (Paper No. 21, filed September 9, 1998).

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

We shall not sustain the rejection of claims 10 through 14 and 16 under 35 U.S.C. § 103.

In rejecting the claims, the examiner relies on Nagy as the primary reference. Nagy discloses "a security lock for a door or other closure" (column 1, lines 7 and 8) comprising a conventional lock cylinder (12) including a barrel (16) having a slot (18) formed therein for receiving a key and a rigid tube (20) attached to the lock cylinder (12), the tube (20) further including a pair of diametrically opposed openings (32) which receive the hasp (34) of a padlock (36). The hasp extends across the interior of the tube (20) to prevent a key from being inserted into the slot (18) and to prevent access to the slot by picking instruments (column 2, lines 47 through 60). A special key (24) having a blade or shank (26) provided with an extension (28) of substantially the length of the tube (20) is required to enable a person to operate the lock by inserting the shank (26) into the slot and then rotating the key and barrel (column 2, lines 36 through 46). The examiner concedes that Nagy does not disclose combination of the security lock with an ignition switch keyway and the security lock having a pair of separate, planar flanges being parallel to the length of the keyway (answer, page 3).

According to the examiner, it would have been obvious, in view of the teachings of Capri, to use the security lock of Nagy with an automobile ignition lock, as required by claim 10 (answer, page 3). We agree with the examiner on this point. The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Nagy discloses a security lock for blocking access to a key slot, but does not specifically disclose use of the security lock on an automobile ignition switch key slot. Capri teaches the provision of a lock device for blocking access to the key slot of an automobile ignition lock cylinder to prevent theft by a person with a master key (column 1, lines 4 through 11). In our opinion, the combined teachings of Nagy and Capri would have suggested to one of ordinary skill in the art use of the key slot blocking security device of Nagy in combination with an automobile ignition switch lock cylinder and barrel to prevent access to the ignition switch key slot.

However, we do not agree with the examiner's position that

It would have been an obvious change of shape to one of ordinary skill in the art to make the cylindrical tube 20 rectangular instead of circular since both configurations provide the same function in substantially the same manner to produce the same results [answer, page 3].

While it may be true that the Nagy security device *could* be modified as proposed by the examiner to make the cylindrical tube (20) rectangular instead of circular while still providing the same function in substantially the same manner to produce the same results, the examiner has supplied no evidence that the prior art suggests the desirability of such a modification. See In re Mills, 916 F.2d 680, 682, 16 USPQ2d 1430, 1432 (Fed. Cir. 1990); In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification."). In our view, the only suggestion for modifying Nagy in the manner proposed by the examiner to meet the above-noted limitations stems from impermissible hindsight knowledge derived from the appellant's

own disclosure. It follows that we cannot sustain the examiner's rejection of independent claim 10 or of claims 11 through 14 and 16 which depend therefrom.



CONCLUSION

To summarize, the decision of the examiner to reject claims 10 through 14 and 16 under 35 U.S.C. § 103 is REVERSED.

REVERSED

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|-----------------------------|---|-----------------|
| LAWRENCE J. STAAB           | ) |                 |
| Administrative Patent Judge | ) |                 |
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|                             | ) | BOARD OF PATENT |
| JOHN P. McQUADE             | ) | APPEALS         |
| Administrative Patent Judge | ) | AND             |
|                             | ) | INTERFERENCES   |
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| JENNIFER D. BAHR            | ) |                 |
| Administrative Patent Judge | ) |                 |

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APPEAL NO. 99-0643 - JUDGE BAHR  
APPLICATION NO. 08/828,225

APJ BAHR

APJ McQUADE

APJ STAAB

DECISION: **REVERSED**

Prepared By: Carolyn Whitfield

**DRAFT TYPED:** 12 Apr 00

**FINAL TYPED:**